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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,535	08/18/2000	Dong-Ho Song	2101785-991100	6807
26379	7590	12/01/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP			BACKER, FIRMIN	
2000 UNIVERSITY AVENUE			ART UNIT	
E. PALO ALTO, CA 94303-2248			PAPER NUMBER	

3621

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/641,535	Applicant(s) SONG ET AL	
	Examiner FIRMN BACKER	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14-17, 19, 21, 23, 25-27, 29, 30, 32-36, 38, 41-47 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-17, 19, 21, 23, 25-27, 29, 30, 32-36, 38, 41-47 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 14<sup>th</sup>, 2005 has been entered.

### ***Response to Amendment***

2. A preliminary amendment has been file with the RCE
3. Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47 have been amendment
4. No claim has been added
5. No claims has been canceled
6. Claims 1-5, 7-12, 14-17, 19, 21.23, 25-27, 29-30, 32-36, 38-9, 41-7 and 49-51 remain pending.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-5, 7-12, 14-17, 19, 21.23, 25-27, 29-30, 32-36, 38-9, 41-47 and 49-51 have been considered but are moot in view of the new ground(s) of rejection.

***Specification***

8. The amendment filed September 14<sup>th</sup>, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "without installing the rental program on the user computer system".

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

9. Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1, 10, 16, 21, 27, 32, 36, 42 and 47 recites the limitation " without installing the rental program on the user computer system". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-5, 7-12, 14-17, 19, 21.23, 25-27, 29-30, 32-36, 38-9, 41-47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (U.S. PG Pub No. 2005/0198239) in view of Benson (U.S. Patent No. 6,334,118).

13. As per claims 1, Hughes teaches a software program a distribute computing environment, wherein the rental software program includes a main executable file (*first portion of an application program*) and optional files (*second portion of an application program*) called by the main executable file are executable the main executable file to implement the rental software (*lease software*) program without the rental software program being installed on the user computer system (*see paragraphs 0008, 0011, 0045*), comprising

a user computer system including mean for initially downloading the main executable file of the rental software program to begin execution of the rental software program and mean if an optional file is missing for automatically requesting one or more optional file contained in the rental software program in order to continue execution of the rental software program using the optional file (*see paragraphs 0033 0050*),

a server computer system for downloading the main executable file contained in the rental software program to be executed in the user computer system and means for automatically downloading the one or more optional files as requested by the computer system (*see paragraphs 0151, 0152, 0153*)

and wherein the user computer system further comprises a process manager means further comprising means for creating and running a process corresponding to the main executable file without installing the rental software program on the user computer software means for suspending the process if the process requests one or more optional files, and means for suspending the process if the process manager means request the one or more optional files from the server computer system (*see paragraphs 0045, 0151, 0152, 0153*)

Hughes fail to teach a system wherein the process manager flushes the main executable file and the optional files of the rental software program from the user computer system so that the rental software program is removed from the user computer system who the rental is completed.

However, Benson teach a system wherein the process manager flushes the main executable file and the optional files of the rental software program from the user computer system so that the rental software program is removed from the user computer system who the rental is completed (*see column 5 line 4-14*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hughes invention to include Benson's system wherein the process manager flushes the main executable file and the optional files of the rental software program from the user computer system so that the rental software program is removed from the user

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computer system who the rental is completed so that at the end of the rental period, the customer is prohibited from the use the software because the customer will no longer be able to provide an appropriate key.

14. As per claims 2, Hughes teach a system comprising a storage mean for storing the main executable file, the one or more optional files contained in the rental software program if downloaded from a list of optional file downloaded from the server computer system; and a monitor means for monitoring the process to determine whether the process requests the one or more optional files and further comprising means for intercepting a message requesting the one or more optional files from the process, one means for automatically requesting the one or more optional file to the server computer system (*see paragraphs 0045, 0151, 0152, 0153*).

15. As per claims 3, Hughes a teach system wherein the server computer system server comprising means for sending the list of optional file to the user computer system where the server computer sends the main executable file to the user computer system and where the optional file includes a registry file (*see paragraphs 0045, 0151, 0152, 0153*).

16. As per claims 4, Hughes a teach system of computer system includes a protection means for protecting to rental software program rental from the server computer system to prevent an unauthorized use committed by the user computer system; a converting means for converting registry file information contained in the list of optional files into registry file information

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appropriate to the user computer system; and a billing database for storing billing information (see paragraphs 0094, 0115, 0163-0173).

17. As per claims 5, Hughes a teach system wherein the billing information include a billing start time, a billing end time and a name of the rental software program selected by the user computer system (see paragraphs 0094, 0115, 0163-0173)..

18. As per claims 7, Hughes a teach system wherein the server computer system include a verification mean a for verifying the user computer system by using identification information of the user computer system stored in a user information database a program database for storing path information of the main executable file, a list of rental software programs and a list of the optional file an analyzing means for analyzing a new rental software program when the new rental software program is installed in the server computer system, wherein the analyzing means further comprises means for storing the path information of the main executable file of a list of file optional files, associated with the new rental software program in the program database; a storage mean for storing the main executable file and the one or more optional file and a means for obtaining and sending the main executable file stored in the storage means when the user computer system selects the desirable rental software program; and means for obtaining and sending the one or more optional files stored in the storage means who the user computer system optionally request the one or more optional file to the server, computer system (see paragraphs 0008, 0011, 0045).



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19. As per claims 8, Hughes a teach system wherein the server compare system further includes a billing means for processing charge or fee to be paid for the usage of the main executable file and the one or more optional files associated with file rental software program provided to the user computer system; a log database for storing a log file necessary for recovering the user computer system with the server computer system is not operable due to a serious error; a recovery mean for recovering the server computer system by using the log file stored in the log database when the server computer system is not operable due to the serious error; a schedule management means for managing a schedule of requests from the user computer system and another user computer system; and a session management means for managing a communication session between the user computer system and the server computer system (*see paragraphs 0008, 0011, 0045*)

20. As per claims 9, Hughes a teach system wherein the server computer system server the list of optional files to the user computer system when the server computer system sends file main executable file the user computer system and wherein the optional file includes a registry file (*see paragraphs 0008, 0011, 0045*).

21: As per claims 10-12, 14-17, 19, 21.23, 25-27, 29-30, 32-36, 38-9, 41-47 and 49-51, they disclose that same inventive concept as claims 1-5 and 7-9 and do not further limit the disclosed invention. Furthermore, the scopes of those claims are clearly taught in the combination of Hughes and Benson. Therefore, they are rejected under the same rationale.

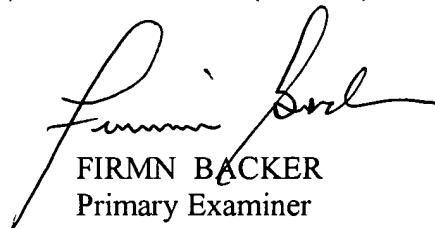
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703.

The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
FIRMN BACKER  
Primary Examiner  
Art Unit 3621

November 22, 2005